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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/444,067      | 11/19/99    | MURPHY               | B 17634-000512      |

020350 HM22/0629  
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EXAMINER

BRUMBACK, B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1642

DATE MAILED:

*S*  
06/29/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/444,067

Applicant(s)

Murphy et al.

Examiner  
Brenda Brumback

Group Art Unit  
1642



☒ Responsive to communication(s) filed on May 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 63-163 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 63-163 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1642

### **DETAILED ACTION**

1. Applicant's amendment filed 05/09/2000 has been entered as Paper # 5. All pending claims were canceled and new claims 63-163 were added. Due to applicant's cancellation of all or the original claims and addition of new claims incorporating additional subject matter, a new restriction requirement follows.

#### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 63-69, 120-122, 162, and 163, drawn to recombinant RSV with a gene deletion and to a method of making, classified in class 435 subclass 235.1.
  - II. Claims 63, 70-78, and 120-122, drawn to recombinant RSV wherein expression of a selected gene is reduced or ablated, classified in class 435, subclass 235.1.
  - III. Claims 63, 79-87, and 120-122, drawn to recombinant RSV wherein the position of one or more genes is altered relative to an RSV promotor, classified in class 435, subclass 235.1.
  - IV. Claims 63, 88-95, and 120-122, drawn to recombinant RSV with a modification modulating a change in phenotype or with attenuating mutations, classified in class 424, subclass 199.1.

Art Unit: 1642

- V. Claims 63, 96-107, and 120-122, drawn to recombinant RSV with heterologous RSV genes, classified in class 424, subclass 199.1.
- VI. Claims 63, 108-115, and 120-122, drawn to recombinant RSV with a nucleotide modification to a cis-acting regulatory sequence, classified in class 435, subclass 235.1.
- VII. Claims 63, 116-118, and 120-122, drawn to recombinant RSV with a PIV gene, classified in class 424, subclass 199.1.
- VIII. Claims 63 and 119-122, drawn to recombinant RSV encoding a non-RSV molecule, classified in class 424, subclass 199.1.
- IX. Claims 63 and 120-131, drawn to a vaccine and a method of stimulating the immune system, classified in class 424, subclass 199.1.
- X. Claims 133-138, drawn to isolated RSV polynucleotides and expression vectors, classified in class 514, subclass 44 or class 435.
- XI. Claims 133 and 139-145, drawn to RSV polynucleotides wherein expression of a selected gene is reduced or ablated, classified in class 514, subclass 44.
- XII. Claims 133 and 146, drawn to RSV polynucleotides wherein the position of one or more genes is altered relative to an RSV promotor, classified in class 514, subclass 44.

Art Unit: 1642

- XIII. Claims 133 and 147-150, drawn to RSV polynucleotides with modifications modulating a change in phenotype or with attenuating mutations, classified in class 514, subclass 44.
- XIV. Claims 133 and 151-155, drawn to RSV polynucleotides with heterologous RSV genes, classified in class 514, subclass 44.
- XV. Claims 133 and 156-159, drawn to isolated RSV polynucleotides with a nucleotide modification to a cis-acting regulatory sequence, classified in class 514, subclass 44.
- XVI. Claims 133 and 160, drawn to isolated RSV polynucleotides with a PIV gene, classified in class 514, subclass 44.
- XVII. Claims 133 and 161, drawn to isolated RSV polynucleotides encoding a non-RSV molecule, classified in class 514, subclass 44.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I-VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the recombinant RSV of claim 63 can be used in the materially different processes of diagnostic testing and affinity purification of antibodies.

Art Unit: 1642

The inventions of Groups I-VIII and X-XVIII have different structures, different functions, and/or different immunological properties.

It is noted that claims 63, 120-122, and 133 are included in more than a single group. These claims will be examined with the elected group to the extent that they read on that group.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and/or by their different classification, restriction for examination purposes as indicated is proper.


5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1642

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Brumback whose telephone number is (703) 306-3220. If the examiner can not be reached, inquiries can be directed to Supervisory Patent Examiner Anthony Caputa whose telephone number is (703) 308-3995. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Examiner Brenda Brumback, Art Unit 1642 and should be marked "OFFICIAL" for entry into prosecution history or "DRAFT" for consideration by the examiner without entry. The Art Unit 1642 FAX telephone number is (703)-305-3014. FAX machines will be available to receive transmissions 24 hours a day. In compliance with 1096 OG 30, the filing date accorded to each OFFICIAL fax transmission will be determined by the FAX machine's stamped date found on the last page of the transmission, unless that date is a Saturday, Sunday or Federal Holiday with the District of Columbia, in which case the OFFICIAL date of receipt will be the next business day.

Brenda Brumback  
June 27, 2000



DONNA WORTMAN  
PRIMARY EXAMINER